

## REMARKS

In response to the Office Action dated September 13, 2004, Applicant cancels claims 37, 92, and 147, without prejudice or disclaimer, amends claims 1, 36, 38, 45, 57, 91, 93, 99, 111, 146, 148, and 155, and adds new claims 167-175. Support for the claim amendments and new claims can be found in the originally-filed specification, claims, and drawings. No new matter has been entered.

Prior to entry of this Amendment, claims 1-166 were pending. After entry of this Amendment, claims 1-36, 38-91, 93-146, and 148-175 are pending. Of the pending claims, claims 1, 7, 10, 36, 45, 57, 62, 65, 91, 99, 111, 117, 120, 146, 155, and 173-175 are independent.

As an initial matter, Applicant thanks the Examiner for indicating that claims 7-9, 62-64, and 117-119 are allowed and that claims 12, 27, 36, 45-56, 67, 82, 91, 99-110, 122, 137, 146, and 155-166 contain allowable subject matter. By this Amendment, Applicant has placed claims 36, 45, 91, 99, 146, and 155 in independent form. Claims 45, 99, and 155 recite all the limitations of the claims from which those claims previously depended. Claims 36, 91, and 146 recite a substantial number of the limitations of the claims from which those claims previously depended. Claims 36, 45-56, 91, 99-110, 146, and 155-166 are thus allowable.

In the Office Action, claims 37, 38, 92, 93, 147, and 148 were objected to for allegedly failing to further limit the subject matter of a previous claim. By this Amendment, claims 37, 92, and 147 have been canceled without prejudice or disclaimer, and claims 38, 93, and 148 have been amended to depend from claims 1, 57, and 111, respectively. Claims 38, 93, and 148 further limit the subject matter of

those respective independent claims and thus the objection to the claims should be withdrawn.

In the Office Action, claims 1-6, 11, 13-26, 28-35, 37-44, 57-61, 66, 68-81, 83-90, 92-98, 111-116, 121, 123-136, 138-145, and 147-154 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,158,913 to Dumler et al. ("Dumler"). Dumler discloses a mascara unit.

Of the claims rejected based on Dumler, claims 1, 57, and 111 are independent. Each of claims 1, 57, and 111 is directed to a device for applying a product, and each recites, among other aspects, that "the application element is configured to remain external to the reservoir."

With reference to Figs. 1-3, Dumler discloses a mascara unit 1 having a reservoir 2 with a bottom 3, a neck 5 opposite the bottom, and an interior space 4. Dumler explicitly discloses that the interior space 4 of the reservoir 2 is "for the take-up of mascara." (Col. 2, lines 24-28.) Dumler further discloses that the applicator in the form of a mascara brush 7 in the exemplary embodiment of Figs. 1-3 dips into the interior space 4 and then is swung out into the position of Fig. 3 for application. (Col. 2, lines 29-33 and 44-50.) Thus, since the mascara brush 7 of Dumler dips into the interior space 4, Dumler fails to disclose or otherwise suggest that "the application element is configured to remain external to the reservoir," as recited in claims 1, 57, and 111, as amended. For at least this reason, therefore, the Section 102 rejection based on Dumler should be withdrawn.

To the extent the Section 102 rejection based on Dumler may apply to new claims 173-175, that rejection should be withdrawn. Claims 173-175 recite many of the

features of independent claims 1, 57, and 111, respectively. Claims 173-174 also recite that “the device is configured to load at least a portion of the application element with product from the reservoir while the application element is positioned in the cavity.” As noted above, Dumler discloses that the mascara brush 7 dips into the interior space 4 for the take-up of mascara. Dumler does not disclose that any portion of the mascara brush 7 becomes loaded with product from the interior space 4 while the mascara brush 7 is positioned outside of interior space 4, for example in the cap-type sliding sleeve 10 of Fig. 2. Thus, Dumler fails to disclose or otherwise suggest that a device “configured to load at least a portion of the application element with product from the reservoir while the application element is positioned in the cavity,” as recited in new claims 173-175. For at least this reason, Dumler cannot anticipate nor render obvious new claims 173-175.

In the Office Action, each of independent claims 10, 65, and 120 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,348,031 to Cloud in view of U.S. Patent No. 6,450,720 to Cai. Cloud discloses a cosmetic apparatus and Cai discloses an applicator and method for applying fluid or paste product to hair or hair-like objects.

Each of claims 10, 65, and 120 recites a device for applying product that includes, among other things, an application element made of a sintered material. In the rejection of these claims, the Examiner acknowledges at page 3 of the Office Action that Cloud fails to disclose an application element made of a sintered material. Indeed, throughout the majority of the patent, Cloud discloses that item 32 in the drawings is a cosmetic product, such as a wax based cosmetic heated into a slurry with the end of the

applicator 14 being dipped into the slurry mixture. (Col. 4, lines 17-28). As pointed out at page 3 of the Office Action, however, Cloud discloses one embodiment wherein the cosmetic 32 is a moisturizer or foundation and an absorbent foam is affixed to the end of the applicator 14.

To allegedly cure the acknowledged deficiency of Cloud, the Examiner relies on Cai, stating that “Cai discloses an application element made of foam, felt sponge, or sintered particles, thus demonstrating that foam and sintered material are functional equivalent porous structures in the art.” Office Action at pp. 3-4. The Examiner then concludes that “it would have been obvious to one skilled in the art to substitute a sintered material for the foam applicator of Cloud in view of Cai.” Office Action at p. 4.

The Section 103 rejection based on Cloud in view of Cai should be withdrawn because the Office Action fails to establish a *prima facie* case of obviousness. For example, contrary to the Examiner’s assertion, for several reasons skilled artisans at the time of Applicant’s invention would not have been motivated to modify the foam applicator disclosed by Cloud by replacing it with the sintered applicator taught by Cai. First, Cloud discloses a cosmetic apparatus for applying cosmetics to skin surfaces, whereas Cai discloses an applicator and method for applying a product to hair. Thus, skilled artisans would not have turned to Cai when modifying the applicator of Cloud as the two applicators are for differing uses.

Further, Cai specifically teaches *against* applying product loaded on the application member 45 to a skin surface. Cai teaches an applicator having a shield “for covering at least part of the application member to **prevent** the surface [or skin] from contacting the application member during use of the applicator” to apply product to hair

or hair-like objects on a surface or skin. (See, e.g., col. 2, lines 11-14.) In particular, referring to the embodiment of Fig. 1, Cai teaches an applicator that includes a shield 36 having curved thin members 69 defining openings 70 therebetween “dimensioned to allow hair or hair-like objects to pass through but to prevent the surface to which the hair or hair-like objects are attached from passing and contacting the application member. (See, Cai, col. 5, lines 18-22.) Cai thus specifically teaches that an object of the invention is to provide a system in which an application member applies a product to hair without smudging or contaminating the skin below or adjacent to the hair. Based on this teaching of avoiding skin contact with the application member (*i.e.*, teaching against an applicator for use in applying product to a skin surface), skilled artisans would not have been motivated to turn to the various application members disclosed in Cai to modify the application member of Cloud that is used for applying moisturizers or foundation to skin.

For at least the above reasons, skilled artisans at the time of Applicant’s invention would not have been motivated to combine Cloud and Cai in the hypothetical manner set forth in the Office Action and a *prima facie* case of obviousness has not been established. The Section 103 rejection based on Cloud and Cai should therefore be withdrawn.

Applicant submits that independent claims 1, 7, 10, 36, 45, 57, 62, 65, 91, 99, 111, 117, 120, 146, 155, and 173-175 are allowable and that any dependent claims which depend from those claims also are allowable for at least the same reasons each respective independent claim is allowable. In addition, at least some of the dependent

claims recite unique features and combinations that are neither taught nor suggested by the cited art and therefore at least some are separately patentable.

Applicant respectfully requests withdrawal of the outstanding claim objection and rejections, and the allowance of pending claims 1-36, 38-91, 93-146, and 148-175.

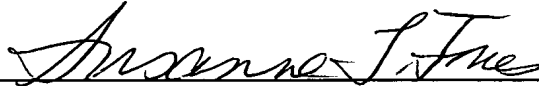
The Office Action contains characterizations and assertions, including characterizations and/or assertions regarding the cited art and Applicant's claims, with which Applicant does not necessarily agree. Unless explicitly noted otherwise herein, Applicant declines to subscribe to any such characterizations and/or assertions set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 13, 2005

By:   
Susanne T. Jones  
Reg. No. 44,472